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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,164	12/31/2003	Gary F. Dandreaux	C-477	1558

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KRAMER LEVIN NAFTALIS & FRANKEL LLP
INTELLECTUAL PROPERTY DEPARTMENT
1177 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER	
SHOSHO, CALLIE E	
ART UNIT	**PAPER NUMBER**
1714	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/751,164	DANDREAUX ET AL.	
	Examiner	Art Unit	
	Callie E. Shosho	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 January 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-13 and 15-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-13 and 15-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/5/07 has been entered.

2. It is noted that applicants' after-final amendment filed 12/13/06 which was previously not entered (see Advisory Action mailed 12/27/06) has now been entered. The following office action is based on this now entered amendment.

3. It is noted that present claims 5, 6, 9, 16, and 18 appear to encompass 0 wt.% rosin, alcohol solvent, plasticizer, and latex emulsion, respectively, i.e. rosin, alcohol solvent, plasticizer, and latex emulsion are not present in the ink. However, given that each claim depends on claim 1 which requires the presence of rosin, alcohol solvent, plasticizer, and latex emulsion, it is clear that the amounts set forth in each of claim 5, 6, 9, and 16 require a finite amount of rosin, alcohol solvent, plasticizer, and latex emulsion be present in the ink, i.e. does not include 0 wt.%

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1, 3-13, 15-16, and 18-20 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 03/0423208.

WO 03/042308 discloses water washable, wet or dry, lithographic ink comprising up to 90%, most preferably, 12-35% rosin-based resin and vinyl resin emulsion , up to 40% pigment, up to 10% pH neutralizer such as monoethanolamine or triethanolamine, up to 90% fatty acid ester, i.e. plasticizer, and alcohol solvent such as propanol, glycol, or glycol ether. From the examples, it is disclosed that the rosin-based resin includes phenolic modified rosin and rosin resin. It is further disclosed that the rosin-based resin possesses both low acid number rosin, i.e. acid number up to 45, and high acid number rosin, acid number of 45-400. It is further disclosed that the ratio of pigment to rosin is 1/8-1/1 (page 1, lines 6-7, page 3, lines 22-25, page 4, lines 5-21 and 34-35, page 6, line 5, page 8, line 10-page 9, line 14, page 10, lines 10-14, 20-21 and 30-37, page 11, lines 7-15 and 20-21),

In light of the above, it is clear that WO 03/042308 anticipates the present claims.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 03/042308 in view Krishnan et al. (U.S. 6,200,372) or Harris et al. (U.S. 6,834,589).

The disclosure with respect to WO 03/042308 in paragraph 4 is incorporated here by reference.

The difference between WO 03/042308 and the present claimed invention is the requirement in the claims of specific type of latex.

WO 03/042308 discloses vinyl emulsion polymer, i.e. latex, however, there is no disclosure of specific latex as presently claimed.

Krishnan et al., which is drawn to inks, disclose the use of 10-70% acrylic resin emulsion, i.e. acrylic latex, as a binder (col.3, lines 7-10, col.3, line 65-col.4, line 5, and col.4, lines 34-35).

Alternatively, Harris et al., which is drawn to inks, disclose the use of 0-40% acrylic latex in order to adjust viscosity and film strength (col.5, lines 59-64).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use acrylic latex as the vinyl emulsion polymer in WO 03/042308 in order to produce ink with good adhesion to substrate or, alternatively, with suitable viscosity and good film strength, and thereby arrive at the claimed invention.

9. Claims 1, 3-6, 8-10, 12-13, 15-16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnan et al. '022 (U.S. 6,444,022) in view of *Hawley's Condensed Chemical Dictionary*

Attention is drawn to example 2 of Krishnan et al. '022 that disclose lithographic composition comprising (i) 60% carbon black base comprising 40% carbon black, 20% rosin

ester, and 3% monoethanolamine, (ii) 20% modified linseed oil comprising 27.94% polyethylene glycol and 16.2% phthalic anhydride, (iii) 25% latex, and (iv) 2% monoethanolamine. From this example, it is calculated that the ink comprises approximately 24% carbon black, 12% rosin ester, 3.8% monoethanolamine, 5.6% polyethylene glycol, 3.24% phthalic anhydride, and 25% latex. It is well known, as evidenced by *Hawley's Condensed Chemical Dictionary* (pages 878-879), that phthalic anhydride functions as a plasticizer. It is also disclosed that the rosin also includes maleic anhydride rosin or rosin salt. It is further disclosed that the ink is used in dry lithography (col.1, lines 5-6, col.3, lines 63-65, and col.4, lines 10 and 31-39).

The difference between Krishnan et al. '022 and the present claimed invention is the requirement in the claims of (a) amount of acid neutralizing agent, i.e. monoethanolamine and (b) acid number of the rosin-based resin.

With respect to difference (a), it is noted that Krishnan et al. '022 disclose the use of 3.8% monoethanolamine, while the present claims require "about 5%" monoethanolamine.

It is apparent, however, that the instantly claimed amount of monoethanolamine and that taught by Krishnan et al. '022 are so close to each other that the fact pattern is similar to the one in *In re Woodruff*, 919 F.2d 1575, USPQ2d 1934 (Fed. Cir. 1990) or *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed.Cir. 1985) where despite a "slight" difference in the ranges the court held that such a difference did not "render the claims patentable" or, alternatively, that "a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough so that one skilled in the art would have expected them to have the same properties".

In light of the case law cited above and given that there is only a "slight" difference between the amount of monoethanolamine disclosed by Krishnan et al. '022 and the amount disclosed in the present claims, it therefore would have been obvious to one of ordinary skill in the art that the amount of monoethanolamine disclosed in the present claims is but an obvious variant of the amount disclosed in Krishnan et al. '022, and thereby one of ordinary skill in the art would have arrived at the claimed invention.

With respect to difference (b), Pennaz, which is drawn to inks, disclose the use of rosin possessing acid number of 25-200 and further disclose that the water-solubility or water-reducible properties of the rosin are controlled by its acid number (col.9, line 57-col.10, line 9).

Given that Krishnan et al. '022 in combination with Pennaz disclose composition as presently claimed, it is clear that the composition would intrinsically be water-washable.

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use rosin possessing acid number of 25 to 200 in Krishnan et al. '022 in order to produce rosin with desired water solubility, and thereby arrive at the claimed invention.

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnan et al. '022 (U.S. 6,444,022) in view of *Hawley's Condensed Chemical Dictionary*

Attention is drawn to example 2 of Krishnan et al. '022 that disclose lithographic composition comprising (i) 60% carbon black base comprising 40% carbon black, 20% rosin ester, and 3% monoethanolamine, (ii) 20% modified linseed oil comprising 27.94% polyethylene glycol and 16.2% phthalic anhydride, (iii) 25% latex, and (iv) 2% monoethanolamine. From this

example, it is calculated that the ink comprises approximately 24% carbon black, 12% rosin ester, 3.8% monoethanolamine, 5.6% polyethylene glycol, 3.24% phthalic anhydride, and 25% latex. It is well known, as evidenced by *Hawley's Condensed Chemical Dictionary* (pages 878-879), that phthalic anhydride functions as a plasticizer. It is also disclosed that the rosin also includes maleic anhydride rosin or rosin salt (col.1, lines 5-6, col.3, lines 63-65, and col.4, lines 10 and 31-39).

The difference between Krishnan et al. '022 and the present claimed invention is the requirement in the claims of (a) amount of acid neutralizing agent, i.e. monoethanolamine, (b) amount of rosin-based resin, and (c) acid number of the rosin-based resin.

With respect to difference (a), it is noted that Krishnan et al. '022 disclose the use of 3.8% monoethanolamine, while the present claims require "about 5%" monoethanolamine.

It is apparent, however, that the instantly claimed amount of monoethanolamine and that taught by Krishnan et al. '022 are so close to each other that the fact pattern is similar to the one in *In re Woodruff*, 919 F.2d 1575, USPQ2d 1934 (Fed. Cir. 1990) or *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed.Cir. 1985) where despite a "slight" difference in the ranges the court held that such a difference did not "render the claims patentable" or, alternatively, that "a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough so that one skilled in the art would have expected them to have the same properties".

With respect to difference (b), it is noted that Krishnan et al. '022 disclose the use of 12% rosin-based resin, while the present claims require "about 15%" rosin-based resin.

It is apparent, however, that the instantly claimed amount of rosin-based resin and that taught by Krishnan et al. '022 are so close to each other that the fact pattern is similar to the one in *In re Woodruff*, 919 F.2d 1575, USPQ2d 1934 (Fed. Cir. 1990) or *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed.Cir. 1985) where despite a "slight" difference in the ranges the court held that such a difference did not "render the claims patentable" or, alternatively, that "a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough so that one skilled in the art would have expected them to have the same properties".

In light of the case law cited above and given that there is only a "slight" difference between the amount of monoethanolamine and the amount of rosin-based resin disclosed by Krishnan et al. '022 and the amounts disclosed in the present claims, it therefore would have been obvious to one of ordinary skill in the art that the amount of monoethanolamine and the amount of rosin-based resin disclosed in the present claims is but an obvious variant of the amounts disclosed in Krishnan et al. '022, and thereby one of ordinary skill in the art would have arrived at the claimed invention.

With respect to difference (c), Pennaz, which is drawn to inks, disclose the use of rosin possessing acid number of 25-200 and further disclose that the water-solubility or water-reducible properties of the rosin are controlled by its acid number (col.9, line 57-col.10, line 9).

Given that Krishnan et al. '022 in combination with Pennaz disclose composition identical to that presently claimed, it is clear that the composition would intrinsically be water-washable.

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use rosin possessing acid number of 25 to 200 in Krishnan et al. '022 in order to produce rosin with desired water solubility, and thereby arrive at the claimed invention.

11. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnan et al. '022 (U.S. 6,444,022) in view of *Hawley's Condensed Chemical Dictionary*

Attention is drawn to example 2 of Krishnan et al. '022 that disclose lithographic composition comprising (i) 60% carbon black base comprising 40% carbon black, 20% rosin ester, and 3% monoethanolamine, (ii) 20% modified linseed oil comprising 27.94% polyethylene glycol and 16.2% phthalic anhydride, (iii) 25% latex, and (iv) 2% monoethanolamine. From this example, it is calculated that the ink comprises approximately 24% carbon black, 12% rosin ester, 3.8% monoethanolamine, 5.6% polyethylene glycol, 3.24% phthalic anhydride, and 25% latex. It is well known, as evidenced by *Hawley's Condensed Chemical Dictionary* (pages 878-879), that phthalic anhydride functions as a plasticizer. It is also disclosed that the rosin also includes maleic anhydride rosin or rosin salt (col.1, lines 5-6, col.3, lines 63-65, and col.4, lines 10 and 31-39).

The difference between Krishnan et al. '022 and the present claimed invention is the requirement in the claims of (a) amount of acid neutralizing agent, i.e. monoethanolamine, (b) acid number of rosin-based resin, and (c) "wet" lithographic printing ink.

With respect to difference (a), it is noted that Krishnan et al. '022 disclose the use of 3.8% monoethanolamine, while the present claims require "about 5%" monoethanolamine.

It is apparent, however, that the instantly claimed amount of monoethanolamine and that taught by Krishnan et al. '022 are so close to each other that the fact pattern is similar to the one in *In re Woodruff*, 919 F.2d 1575, USPQ2d 1934 (Fed. Cir. 1990) or *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed.Cir. 1985) where despite a "slight" difference in the ranges the court held that such a difference did not "render the claims patentable" or, alternatively, that "a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough so that one skilled in the art would have expected them to have the same properties".

In light of the case law cited above and given that there is only a "slight" difference between the amount of monoethanolamine disclosed by Krishnan et al. '022 and the amount disclosed in the present claims, it therefore would have been obvious to one of ordinary skill in the art that the amount of monoethanolamine disclosed in the present claims is but an obvious variant of the amount disclosed in Krishnan et al. '022, and thereby one of ordinary skill in the art would have arrived at the claimed invention.

With respect to difference (b), Pennaz, which is drawn to inks, disclose the use of rosin possessing acid number of 25-200 and further disclose that the water-solubility or water-reducible properties of the rosin are controlled by its acid number (col.9, line 57-col.10, line 9).

Given that Krishnan et al. '022 in combination with Pennaz disclose composition identical to that presently claimed, it is clear that the composition would intrinsically be water-washable.

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use rosin possessing acid number of 25 to 200 in Krishnan et al. '022 in order to produce rosin with desired water solubility, and thereby arrive at the claimed invention.

With respect to difference (c), while there is no disclosure that the ink is a "wet" lithographic printing ink as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that "if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction". Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the purpose or intended use, i.e. "wet" lithographic printing ink, recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art ink and further that the prior art structure which is ink identical to that presently claimed is capable of performing the recited purpose or intended use, and thus, one of ordinary skill in the art would have arrived at the present invention.

12. Claims 1, 3-13, and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnan et al. '646 (U.S. 5,725,646) in view of Takayama et al. (U.S. 6,313,066) and Pennaz (U.S. 5,338,351).

Krishnan et al. '646 disclose lithographic ink comprising 0.5-10% rewetting agent, i.e. ethylene glycol or butyl carbitol, 2-30% pigment, amine such as monoethanolamine, 10-70% binder comprising 0-20% resin emulsion, i.e. latex obtained from (meth)acrylate and styrene, 10-70% rosin including rosin salt and maleated rosin ester, and 0-5% polyethylene imine. It is further disclosed that the ink is used in dry lithography. Attention is drawn to example 1 of Krishnan et al. '646 that discloses lithographic ink comprising 12% pigment, 5% latex, 2% monoethanolamine, 47% maleated rosin ester, and 2% polyethylene wax. It is well known as evidenced by Takayama et al. (col.9, lines 60-62) that polyethylene wax functions as plasticizer (col.1, lines 5-10, col.3, lines 15-40 and 46, col.3, line 55-col.4, line 12, and example 1). Given that Krishnan et al. '646 disclose composition identical to that presently claimed, it is clear that the composition would intrinsically be water-washable and suitable for use as wet lithographic printing ink.

The difference between Krishnan et al. '646 and the present claimed invention is the requirement in the present claims of acid number of the rosin-based resin.

Pennaz, which is drawn to inks, disclose the use of rosin possessing acid number of 25-200 and further disclose that the water-solubility or water-reducible properties of the rosin are controlled by its acid number (col.9, line 57-col.10, line 9).

Given that Krishnan et al. '022 in combination with Pennaz disclose composition identical to that presently claimed, it is clear that the composition would intrinsically be water-washable and suitable for use as wet lithographic printing ink.

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use rosin possessing acid number of 25 to 200 in Krishnan et al. '646 in order to produce rosin with desired water solubility, and thereby arrive at the claimed invention.

Response to Arguments

13. Applicants' arguments have been fully considered but they are not persuasive.

Specifically, applicants argue that Krishnan et al. '022 is not a relevant reference against the present claims given that there is no disclosure in Krishnan et al. '022 of water-washable ink composition comprising rosin-based resin with acid number of about 20 to about 250 which can be solubilized in water with acid neutralizing agents to become water-washable. Rather, applicants argue that Krishnan et al. '022 disclose modified rosin polymer which is soluble in water regardless of the pH of the water.

However, attention is drawn to col.4, lines 6-16 of Krishnan et al. '022 which discloses that the modified rosin is soluble in water at pH ranging from about 7.5 to about 10 and further that neutralizers are added to adjust the pH to desired value. Thus, contrary to applicants' arguments, it appears that the rosin is only soluble in water at certain pH. Further, given that Krishnan et al. '022 disclose neutralizer identical to those presently claimed, it would appear that the neutralizer would intrinsically solubilize the rosin as required in the present invention.

It is agreed that there is no disclosure of the acid number of the rosin as now required in all the present claims. However, this is why Krishnan et al. '022 is now used in combination with Pennaz, which is drawn to lithographic ink, and which discloses using rosin possessing acid number of 25-200.

Applicants argue that Pennaz is not a relevant reference against the present claims given that Pennaz discloses avoid pre-neutralizing the rosin and given that Pennaz disclose printing at acidic conditions.

However, it is noted that Pennaz is not used for its teaching of neutralizing agent; this is already taught by Krishnan et al. '022. Further, is noted that Pennaz is not used for its teaching of printing conditions. It is further noted that while Pennaz does not disclose all the features of the present claimed invention, Pennaz is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely, the acid number of rosin found in lithographic ink, and in combination with the primary reference, discloses the presently claimed invention.

Thus, given that Krishnan et al. '022 in combination with Pennaz disclose composition as presently claimed, including rosin with acid number as presently claimed and acid neutralizing agent, it is the examiner's position that the composition of Krishnan et al. '022 is intrinsically water-washable.

Similarly, applicants argue that Krishnan et al. '646 is not a relevant reference against the present claims given that there is no disclosure of the acid number of the rosin and no disclosure of acid neutralizing agent which solubilizes the resin in water and renders it water-washable.

However, it is noted that Krishnan et al. '646 disclose that the ink comprises monoethanolamine which is identical to the neutralizing agent presently claimed. Although there is no disclosure that the monoethanolamine solubilizes the rosin, firstly, it is noted that there is no requirement in the present claims regarding the acid neutralizer solubilizing the rosin, and secondly, given that Krishnan et al. '646 disclose rosin as presently claimed and monoethanolamine as presently claimed, it would appear that the neutralizing agent would intrinsically solubilize the rosin.

It is agreed that there is no disclosure of the acid number of the rosin as now required in all the present claims. However, this is why Krishnan et al. '646 is now used in combination with Pennaz, which is drawn to ink, and which discloses using rosin possessing acid number of 25-200.

Applicants argue that Pennaz is not a relevant reference against the present claims given that Pennaz discloses avoid pre-neutralizing the rosin and given that Pennaz disclose printing at acidic conditions.

However, it is noted that Pennaz is not used for its teaching of neutralizing agent; this is already taught by Krishnan et al. '646. Further, is noted that Pennaz is not used for its teaching of printing conditions. It is further noted that while Pennaz does not disclose all the features of the present claimed invention, Pennaz is used as teaching reference, and therefore, it is not necessary

for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely, the acid number of rosin found in lithographic ink, and in combination with the primary reference, discloses the presently claimed invention.

Thus, given that Krishnan et al. '646 in combination with Pennaz disclose composition as presently claimed, including rosin with acid number as presently claimed and acid neutralizing agent, it is the examiner's position that the composition of Krishnan et al. '646 is intrinsically water-washable.

Applicants argue that Takayama et al. each away from the present invention.

However, it is noted that Takayama et al. is merely used as a teaching reference in order to teach that polyethylene wax, disclosed by Krishnan et al., does in fact function as a plasticizer.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
2/20/07